

REMARKS

Claims 1-22 are pending in the application. In the Office Action dated June 23, 2005, the Examiner rejected claims 1-6, 8-13, 15-20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,335,760 ("Sato") in view of U.S. Pat. No. 6,778,607 ("Zaccarin"). Further, claims 7, 14, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Zaccarin and U.S. Pat. No. 5,604,494 ("Murakami"). Applicants respectfully request reconsideration and withdrawal of the rejections in light of the following remarks.

I. It Is Improper to Combine Sato and Zaccarin to Render the Currently-Claimed Invention

Independent claims 1, 8, and 15 are directed to a method and system that provides a plurality of levels of compression using a single compression engine. The currently-claimed invention discloses a method and system that provides a first and second DCT-encoded signal, wherein the coefficients of the second DCT-encoded signal has less coefficient bits than the coefficients of the first DCT-encoded signal. The coefficients of the second DCT-encoded signal are created by removing at least one lesser-significant bit from each of the coefficients of the first DCT-encoded signal. Sato and Zaccarin cannot be combined to render independent claims 1, 8, and 15, or any of their dependent claims, unpatentable.

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP §§ 2141.02 and 2145. Sato and Zaccarin teach away from each other due to the fact Sato teaches an **efficient** method to produce a **single signal** with a resolution dependant on a **single display** in communication with the Sato system where Zaccarin teaches a method for encoding a signal at different bit rates for **multiple displays**. Altering Sato to produce multiple signals teaches away from the **efficient** method of producing a **single signal** dependant on a **single display** disclosed in Sato.

Sato is directed to a image signal reproduction device provided in an electronic still camera. The object of Sato is “to provide an image reproduction device in which a resolution or gradation of an image can be changed in accordance with an indicated performance of a display.” (Col. 1, lines 35-38.) Generally, an image processor expands a compressed image signal to reproduce an image with a predetermined resolution beginning with a low resolution. (Col. 1, lines 44-52). As admitted by the Examiner in the Office Action dated June 23, 2005, Sato fails to disclose providing signals with different resolutions at the same time. Only one signal is produced in Sato to permit “an original high resolution image to be efficiently indicated on a variety of displays, of varying inherent resolutions. . .” (Col. 8, lines 55-57.) Altering Sato to provide a plurality of video streams as disclosed in Figures 3 and 4 of Zaccarin teaches away from the purpose of Sato of providing an *efficient* method to produce a *single signal* with a resolution dependent on a *single display*.

Due to the fact Sato and Zaccarin teach away from each other, Applicants respectfully request the withdrawal of the rejection to claims 1-6, 8-13, 15-20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Zaccarin.

II. The Proposed Combination of Sato, Zaccarin and Murakami Does Not Render the Independent Claims Unpatentable

As discussed above, it is improper to combine Sato and Zaccarin due to the fact Sato and Zaccarin teach away from each other. The addition of Murakami does not reconcile the fact that Sato and Zaccarin teach away from each other. Murakami is directed to an encoding/decoding apparatus that alleviates errors after repeatedly encoding/decoding a digital signal. Murakami does not disclose or suggest providing a plurality of levels of compression like the currently-claimed invention or reconcile the fundamental differences between the system of Sato of providing an *efficient* method to produce a *single signal* with a resolution dependent on a *single display* with the system of Zaccarin of encoding a signal at different bit rates for *multiple displays*.

Due to the fact that Murakami fails to reconcile the improper combination of Sato and Zaccarin discussed above, Applicants respectfully request reconsideration and

Application No. 10/037,453
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Response to Office Action of June 23, 2005

withdrawal of the rejection to claims 7, 14, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Zaccarin and Murakami.

III. CONCLUSION

In view of the foregoing remarks, Applicants submit that the pending claims are in condition for allowance. Reconsideration is therefore respectfully requested. If there are any questions concerning this Response, the Examiner is asked to phone the undersigned attorney at (312) 321-4200.

Respectfully submitted,



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